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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/656,893	09/04/2003	Troy Simmons	43789-268902	1534
826	7590	12/15/2004	EXAMINER	
<b>ALSTON &amp; BIRD LLP</b> <b>BANK OF AMERICA PLAZA</b> <b>101 SOUTH TRYON STREET, SUITE 4000</b> <b>CHARLOTTE, NC 28280-4000</b>				POE, MICHAEL I
		ART UNIT		PAPER NUMBER
				1732

DATE MAILED: 12/15/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	10/656,893	SIMMONS ET AL.
	Examiner Michael I Poe	Art Unit 1732

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) Responsive to communication(s) filed on 04 September 2003.  
 2a) This action is **FINAL**.                    2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) Claim(s) 1-12 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) Claim(s) 12 is/are allowed.  
 6) Claim(s) 1-11 is/are rejected.  
 7) Claim(s) 4 is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on 01 June 2004 is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | Paper No(s)/Mail Date. _____  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>20040122</u> . | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
|   | 6) <input type="checkbox"/> Other: _____                                    |

Art Unit: 1732

**DETAILED ACTION**

***Drawings***

1. The drawings were received on June 1, 2004. These drawings are approved.

***Specification***

2. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed. Since the claims are directed only to a method, the title should only be directed to the claimed method rather than a method, an apparatus and an appearance.
3. The abstract of the disclosure is objected to because: (1) "method" should be "method," in line 9; and (2) "and or" should be "and/or" in line 18. Correction is required. See MPEP § 608.01(b).
4. The disclosure is objected to because of the following informalities: (1) "and or" should be "and/or" on page 8, line 17; and (2) "60/441,336" should be "60/441,366" on page 1, line 10.

Appropriate correction is required.

***Double Patenting***

5. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

6. Claims 5-8 and 10 are provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1-5 of copending Application No. 10/347,663. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

Art Unit: 1732

Note that, although claim 7 of the instant application recites "Mission tile shapes" whereas claim 3 of copending Application No. 10/347,663 recites "two-Piece Mission tile shapes", claim 7 of the instant application is claiming the same invention as claim 3 of copending Application No. 10/347,663 as discussed further hereafter. Specifically, the applicant uses the terms "mission tile shapes" and "two-piece mission tile shapes" interchangeably in the instant original disclosure; therefore, the aforementioned claims would have the same interpretation and would be claiming the same invention although not identically worded.

7. Claims 5-8 and 10 are directed to the same invention as that of claims 1-5 of commonly assigned Application No. 10/347,663. The issue of priority under 35 U.S.C. 102(g) and possibly 35 U.S.C. 102(f) of this single invention must be resolved.

Since the U.S. Patent and Trademark Office normally will not institute an interference between applications or a patent and an application of common ownership (see MPEP § 2302), the assignee is required to state which entity is the prior inventor of the conflicting subject matter. A terminal disclaimer has no effect in this situation since the basis for refusing more than one patent is priority of invention under 35 U.S.C. 102(f) or (g) and not an extension of monopoly.

Failure to comply with this requirement will result in a holding of abandonment of this application.

8. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Art Unit: 1732

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer.

A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

9. Claim 9 is provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of copending Application No. 10/347,663 in view of Great Britain Patent No. 2,200,930 A (Hill).

**Claim 9**

As set forth above, claim 5 of the instant application, upon which claim 9 is dependent, is the same as claim 1 of copending Application No. 10/347,663. Therefore, claim 1 of copending Application No. 10/347,663 teaches all of the limitations of claim 5. However, claim 1 of copending Application No. 10/347,663 does not specifically teach that the simulation interface channel is rectangular. Hill teaches a method of making a roof tile with a mock-joint including forming a mock-joint (a simulation interface channel) in the continuous ribbon using a slipper having a blade member formed integrally therewith to give the appearance that the tile is comprised of more than one tile in side-by-side relationship on a roof wherein the mock-joint has a rectangular shape (said simulation interface channel is rectangular) (abstract; page 1, lines 4-18; page 2, lines 6-10; page 4, lines 6-21; page 7, lines 11-15; Figures). It would have been *prima facie* obvious to one of ordinary skill in the art at the time the invention was made and one of ordinary skill would have been motivated to provide a rectangular simulation interface channel in the process of claim 1 of copending Application No. 10/347,663 as taught by Hill to provide a standard shaped simulation interface channel that accurately replicates standard joints in roofing structures.

This is a provisional obviousness-type double patenting rejection.

10. Claim 9 is directed to an invention not patentably distinct from claim 1 of commonly assigned Application No. 10/347,663. Specifically, claim 9 of the instant application is not patentably distinct from claim 1 of commonly assigned Application No. 10/347,663 in view of Hill for the reasons set forth in the obvious-type double patenting rejection above.

The U.S. Patent and Trademark Office normally will not institute an interference between applications or a patent and an application of common ownership (see MPEP § 2302). Commonly assigned Application No. 10/347,663, discussed above, would form the basis for a rejection of the noted claims under 35 U.S.C. 103(a) if the commonly assigned case qualifies as prior art under 35 U.S.C.

Art Unit: 1732

102(e), (f) or (g) and the conflicting inventions were not commonly owned at the time the invention in this application was made. In order for the examiner to resolve this issue, the assignee can, under 35 U.S.C. 103(c) and 37 CFR 1.78(c), either show that the conflicting inventions were commonly owned at the time the invention in this application was made, or name the prior inventor of the conflicting subject matter.

A showing that the inventions were commonly owned at the time the invention in this application was made will preclude a rejection under 35 U.S.C. 103(a) based upon the commonly assigned case as a reference under 35 U.S.C. 102(f) or (g), or 35 U.S.C. 102(e) for applications filed on or after November 29, 1999.

#### ***Claim Objections***

11. Claim 4 is objected to because of the following informalities: (1) ";" should be inserted after "second slipper" in line 4 of claim 4. Appropriate correction is required.

#### ***Claim Rejections - 35 USC § 102***

12. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

13. Claims 1 and 2 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 1,993,086 (Chaffee).

Art Unit: 1732

**Claims 1 and 2**

Chaffee teaches a method for making roofing (a method of providing multiple tile shapes from one tile mold) including molding or pressing a wet base material to form a shingle slab having a side elevation contour (providing a first tile shape by use of said tile mold) and scoring the underside the shingle slab so that odd sized units may be obtained by merely breaking each large unit along a desired score over a straight edge (providing a second tile shape by providing a channel configured to facilitate breakage of the second tile shape into two separate tiles) (page 2, column 1, lines 25-68; page 3, column 1, lines 50-58). Chaffee further teaches that the score lines are parallel to grooves 7. As such, all of the shingles broken off of shingle slab would inherently have a rectangular shape (two similar shapes are provided for said second tile).

14. Claims 5-8 and 10 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by U.S. Patent Publication No. 2004/0237442 A1 (Simmons).

The applied reference has a common inventor with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

15. Claims 5-7 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 3,349,534 (Wotherspoon).

**Claims 5-7**

Wotherspoon teaches a method for forming a one-piece roofing tile (a method of providing a tile shape) having integrally concave and convex sections which may be quickly and easily laid in a minimum of time to form a Mission roof including extruding a tile by filling a movable die with concrete (providing a first tile shape by use of said mold); and passing the movable die under a stationary die such that the movable die forms the upper face of the tile and the stationary die forms the under face of the tile wherein a shadow shoulder 25 (a simulation interface channel) extending downwardly from the upper face gives the tile the appearance, when laid on a roof, of being made of two separate but overlapping convex and concave sections of a Mission roof (simulating two tile shapes; providing the simulation of two separate

Art Unit: 1732

second tile shapes by a single tile shape by providing a simulation interface channel at a location between two portions of said first tile; two similar shapes are simulated for said second tile shapes; said first tile shape is an S-tile shape and said second tile shapes are two-Piece Mission tile shapes) (column 1, lines 22-25; column 3, lines 51-60; column 4, lines 4-17; column 2, lines 23-27; Figures).

16. Claims 5, 6, 8 and 9 are rejected under 35 U.S.C. 102(b) as being anticipated by Great Britain Patent No. 2,200,930 A (Hill).

**Claims 5, 6, 8 and 9**

Hill teaches a method of making a roof tile (a method of providing a tile shape) with a mock-joint including feeding mortar to a hopper extruder to form a continuous ribbon on a series of pallets (providing a first tile shape by use of said mold) conveyed beneath the hopper extruder; forming a mock-joint (a simulation interface channel) in the continuous ribbon using a slipper having a blade member formed integrally therewith to give the appearance that the tile is comprised of more than one tile in side-by-side relationship on a roof (simulating two tile shapes; providing the simulation of two separate second tile shapes by a single tile shape by providing a simulation interface channel at a location between two portions of said first tile; two similar shapes are simulated for said second tile shapes); and injecting a secondary material into and/or onto the surfaces of the mock-joint to highlight the joint in the finished roof tile (said simulation interface channel is darkened to provide a shadow effect) (abstract; page 1, lines 4-18; page 2, lines 6-10; page 4, lines 6-21; page 7, lines 11-15). As illustrated in the Figures, Hill further teaches that the mock-joint has a rectangular shape.

***Claim Rejections - 35 USC § 103***

17. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Art Unit: 1732

18. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 3,349,534 (Wotherspoon) in view of U.S. Patent No. 1,993,086 (Chaffee).

**Claim 3**

Wotherspoon teaches a method for forming a one-piece roofing tile (a method of providing multiple tile shapes from one tile mold) having integrally concave and convex sections which may be quickly and easily laid in a minimum of time to form a Mission roof including extruding a tile by filling a movable die with concrete (providing a first tile shape by use of said mold); and passing the movable die under a stationary die such that the movable die forms the upper face of the tile and the stationary die forms the under face of the tile wherein a shadow shoulder 25 extending downwardly from the upper face gives the tile the appearance, when laid on a roof, of being made of two separate but overlapping convex and concave sections of a Mission roof (providing a second tile shape by providing a channel; said first tile shape is an S-tile shape and said two separate tiles of said second tile shape are two-Piece Mission tile shapes, one being a "cap" type and one being a "pan" type) (column 1, lines 22-25; column 3, lines 51-60; column 4, lines 4-17; column 2, lines 23-27; Figures).

Wotherspoon does not specifically teach that the channel is configured to facilitate breakage of the second tile shape into two separate tiles. However, Chaffee teaches a method for making roofing (a method of providing multiple tile shapes from one tile mold) including molding or pressing a wet base material to form a shingle slab having a side elevation contour (providing a first tile shape by use of said tile mold) and scoring the underside the shingle slab so that odd sized units may be obtained by merely breaking each large unit along a desired score over a straight edge (providing a second tile shape by providing a channel configured to facilitate breakage of the second tile shape into two separate tiles) (page 2, column 1, lines 25-68; page 3, column 1, lines 50-58). It would have been prima facie obvious to one of ordinary skill in the art at the time the invention was made and one of ordinary skill would have been motivated to use the channel (e.g., the shadow shoulder 25) in the process of Wotherspoon as a channel configured to facilitate breakage as taught by Chaffee to allow an installer to custom configure the shape of the tiles during the installation process.

Art Unit: 1732

19. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 3,349,534 (Wotherspoon) in view of U.S. Patent No. 1,993,086 (Chaffee) and U.S. Patent No. 5,743,059 (Fifield).

**Claim 4**

Wotherspoon teaches a method for forming a one-piece roofing tile (a method of providing multiple tile shapes from one tile mold) having integrally concave and convex sections which may be quickly and easily laid in a minimum of time to form a Mission roof including extruding a tile by filling a movable die with concrete (providing a first tile shape by use of said mold); and passing the movable die under a stationary die such that the movable die forms the upper face of the tile and the stationary die forms the under face of the tile wherein a shadow shoulder 25 extending downwardly from the upper face gives the tile the appearance, when laid on a roof, of being made of two separate but overlapping convex and concave sections of a Mission roof (providing a second tile shape by use of said tile mold and a second slipper; providing a channel) (column 1, lines 22-25; column 3, lines 51-60; column 4, lines 4-17; column 2, lines 23-27; Figures).

Wotherspoon does not specifically teach that the channel is a separation channel and breaking the tile along the separation channel. However, Chaffee teaches a method for making roofing (a method of providing multiple tile shapes from one tile mold) including molding or pressing a wet base material to form a shingle slab having a side elevation contour (providing a first tile shape by use of said tile mold) and scoring the underside the shingle slab so that odd sized units may be obtained by merely breaking each large unit along a desired score over a straight edge (providing a second tile shape by use of said tile mold; providing a separation channel; breaking said second tile shape along said separation channel) (page 2, column 1, lines 25-68; page 3, column 1, lines 50-58). It would have been prima facie obvious to one of ordinary skill in the art at the time the invention was made and one of ordinary skill would have been motivated to use the channel (e.g., the shadow shoulder 25) in the process of Wotherspoon as a channel configured to facilitate breakage as taught by Chaffee to allow an installer to custom configure the shape of the tiles during the installation process.

Art Unit: 1732

Neither Wotherspoon nor Chaffee specifically teaches that the tile mold could be used to provide multiple different tile shapes by using multiple different slippers. However, Fifield teaches a method of forming a roof tile including forming a roofing tile using an extruder, a pallet, a roller and a slipper wherein new profiles for the upper surface of the roof tile are produced merely by changing or adapting the roller and slipper means used to compress the tile making material (abstract; column 1, lines 3-5 and 34-65; column 3, lines 27-37; column 3, line 51 - column 4, line 3). It would have been *prima facie* obvious to one of ordinary skill in the art at the time the invention was made and one of ordinary skill would have been motivated to modify the upper surface profile of the roof tile by changing the slipper (e.g., first and second slippers and one tile mold) in the process of Wotherspoon in view of Chaffee as taught by Fifield to provide flexibility in the profile of the roof tiles being produced while having a low entry cost in terms of tooling (see specifically column 2, lines 22-25 of Fifield).

20. Claim 9 is rejected under 35 U.S.C. 103(a) as being obvious over U.S. Patent Publication No. 2004/0237442 A1 (Simmons) in view of Great Britain Patent No. 2,200,930 A (Hill).

The applied reference has a common inventor with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art only under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 103(a) might be overcome by: (1) a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not an invention "by another"; (2) a showing of a date of invention for the claimed subject matter of the application which corresponds to subject matter disclosed but not claimed in the reference, prior to the effective U.S. filing date of the reference under 37 CFR 1.131; or (3) an oath or declaration under 37 CFR 1.130 stating that the application and reference are currently owned by the same party and that the inventor named in the application is the prior inventor under 35 U.S.C. 104, together with a terminal disclaimer in accordance with 37 CFR 1.321(c). For applications filed on or after November 29, 1999, this rejection might also be overcome by showing that the subject matter of the reference and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person. See MPEP § 706.02(l)(1) and § 706.02(l)(2).

Art Unit: 1732

### **Claim 9**

As set forth above, Simmons anticipates claim 5 of the instant application, upon which claim 9 is dependent. Therefore, Simmons teaches all of the limitations of claim 5. However, Simmons does not specifically teach that the simulation interface channel is rectangular. Hill teaches a method of making a roof tile with a mock-joint including forming a mock-joint (a simulation interface channel) in the continuous ribbon using a slipper having a blade member formed integrally therewith to give the appearance that the tile is comprised of more than one tile in side-by-side relationship on a roof wherein the mock-joint has a rectangular shape (said simulation interface channel is rectangular) (abstract; page 1, lines 4-18; page 2, lines 6-10; page 4, lines 6-21; page 7, lines 11-15; Figures). It would have been prima facie obvious to one of ordinary skill in the art at the time the invention was made and one of ordinary skill would have been motivated to provide a rectangular simulation interface channel in the process of Simmons as taught by Hill to provide a standard shaped simulation interface channel that accurately replicates standard joints in roofing structures.

21. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Great Britain Patent No. 2,200,930 A (Hill) in view of U.S. Patent No. 5,743,059 (Fifield).

### **Claim 10**

Hill teaches a method of making a roof tile (a method of providing a single tile) with a mock-joint including feeding mortar to a hopper extruder to form a continuous ribbon on a series of pallets (one tile mold conveyed beneath the hopper extruder; forming a mock-joint (a simulation interface channel) in the continuous ribbon using a slipper having a blade member formed integrally therewith to give the appearance that the tile is comprised of more than one tile in side-by-side relationship on a roof (simulating multiple tiles; providing a second tile shape by use of said tile mold and a slipper, said slipper providing a simulation interface channel); and injecting a secondary material into and/or onto the surfaces of the mock-joint to highlight the joint in the finished roof tile (abstract; page 1, lines 4-18; page 2, lines 6-10; page 4, lines 6-21; page 7, lines 11-15).

Art Unit: 1732

Hill does not specifically teach that the tile mold could be used to provide multiple different tile shapes by using multiple different slippers. However, Fifield teaches a method of forming a roof tile including forming a roofing tile using an extruder, a pallet, a roller and a slipper wherein new profiles for the upper surface of the roof tile are produced merely by changing or adapting the roller and slipper means used to compress the tile making material (abstract; column 1, lines 3-5 and 34-65; column 3, lines 27-37; column 3, line 51 - column 4, line 3). It would have been prima facie obvious to one of ordinary skill in the art at the time the invention was made and one of ordinary skill would have been motivated to modify the upper surface profile of the roof tile by changing the slipper (e.g., first and second slippers and one tile mold) in the process of Hill as taught by Fifield to provide flexibility in the profile of the roof tiles being produced while having a low entry cost in terms of tooling (see specifically column 2, lines 22-25 of Fifield).

22. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 1,993,086 (Chaffee).

#### **Claim 11**

Chaffee teaches a method for making roofing (a method of providing multiple tile shapes from one tile mold) including molding or pressing a wet base material to form shingle slabs (forming a plurality of said second tile shapes) having a side elevation contour (providing a first tile shape by use of said tile mold) and scoring the underside the shingle slab so that odd sized units may be obtained by merely breaking each large unit along a desired score over a straight edge (providing a second tile shape by providing a channel configured to facilitate breakage of the second tile shape into two separate tiles) (page 2, column 1, lines 25-68; page 3, column 1, lines 50-58). Chaffee further teaches that contractors doing the installing of the shingles decide which shingle slabs to break (page 3, column 1, lines 50-58). Since the contractors would only break the shingle slabs as need, one of ordinary skill in the art would have obviously recognized that the contractors would break some of the shingle slabs while leaving some of the shingle slabs intact (e.g., breaking only a portion of said plurality of said second tile shapes).

Art Unit: 1732

***Allowable Subject Matter***

23. Claim12 is allowed.
24. The following is an examiner's statement of reasons for allowance:
  - (1) The prior art of record does not teach or suggest the claimed method of providing a roof structure, as a whole, especially including providing a first tile shape including a cap portion; providing a second tile shape including a pair of breakage channels configured to facilitate breakage of the second tile shape into three sections; installing the first tile shape atop a supporting structure; and attaching one of the three sections atop the cap portion of the first tile shape.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

***Conclusion***

25. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. U.S. Patent No. 4,092,092 (Dye et al.), U.S. Patent No. 4,666,468 (Brittain), U.S. Patent No. 4,758,148 (Jidell), U.S. Patent No. 5,613,337 (Plath et al.), U.S. Patent No. 5,651,226 (Archibald), and U.S. Patent No. RE38,210 E (Plath et al.) have been cited of interest to show the state of the art at the time the invention was made. U.S. Patent Publication No. 2004/0123544 A1 (Simmons et al.) has been cited of interest to provide the printed publications for this application. U.S. Patent No. 4,695,418 (Baker et al.) has been cited of interest to show a process wherein the blade of a slipper is selectively applied to form channels as has been disclosed by the applicant.

26. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael I Poe whose telephone number is (571) 272-1207. The examiner can normally be reached on Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Colaianni can be reached on (571) 272-1196. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 1732

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